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| 09/666,642 | 09/21/2000 | Hu Yang | 2039.008200 | 9201 |

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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,642

Applicant(s)

YANG ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-30, 32-73, 75-91 and 93-115 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 16, 38, 42, 67-69, 81-83, 85, 99-101 and 113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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With regard to the previous Office action, it is noted that no correspondence was present in the Office action and the Office action appears to have been erroneously mailed by Office support staff. The Examiner regrets the error. This Office action will accordingly be made non-final.

Claims 111, 112 and 114 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

The limitation "consists essentially of a polyethylenic backbone" was not present in the specification as filed and is therefore new matter.

The specification as filed did not disclose the specific compatibilizers of claims 16-18, 42- 44, 85-87, 110-114 for use with polyethyleneic backbone polymers.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bansleben et al. (U.S. 6,255,248) in view of Cahill et al. (U.S. 6,083,585).

See the first Office action at the paragraph bridging pages 3 and 4 et seq.

Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-88, 90, 91, 93-98 and 102-109 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gauthier et al. (U.S. 6,313,241).

Gauthier discloses numerous examples of ethylene/vinyl cyclohexene copolymers in their Examples. Note that films were co-extruded with the polymers in column 24 lines 24-25 to laminate the polymers with materials such as inherently oxygen barrier polymers such as ethylene vinyl alcohol in Example 37. The vinyl cyclohexene polymers of Gauthier may be combined with barrier polymers at column 7 line 35. The polymers are disclosed to be oxygen scavenging and may contain a metal catalyst at column 8 lines 10-16. Photoinitiators may be added such as those of applicants at column 6 lines 1-30.

There are no specific examples containing all of applicants' components in combination although such lies within the broad ambit of the reference. With regard to specific oxygen barrier polymers with the exception of ethylene vinyl alcohol, applicants' specification admits that applicants' oxygen barrier polymers were known as such at the time of the invention at the top of page 3.

Choice of the specific combination of materials from the reference as claimed by applicants would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate

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results absent any showing of surprising or unexpected results. With regard to the use of oxygen barrier polymers besides ethylene vinyl alcohol, use of such would have been obvious to a practitioner having ordinary skill in the art at the time of the invention given that patentees specifically disclose that oxygen barrier polymers may be added and motivated by the need for an oxygen barrier polymer in the composition of the primary reference absent any showing of surprising or unexpected results.

With regard to the use of compatibilizer in paragraph 109, it is the position of the Examiner that compatibilizers were widely known at the time of the invention. In any case, applicants' specification at the top of page 4 uses the word "compatibilizer" without a definition and it appears that applicants are not claiming to have coined the term. As compatibilizer lends compatibility, a desirable quality to a blend, it would have therefore been obvious to a practitioner having ordinary skill in the art at the time of the invention to add a compatibilizer to the composition of the primary reference in order to achieve the benefits of compatibility absent any showing of surprising or unexpected results.

Applicants' arguments filed February 22, 2005 have been fully considered but they are not deemed to be persuasive.

With regard to the language "consisting essentially of", applicants' remarks rely upon Naga. However applicants have still not resubmitted Naga as was requested in the Advisory Action. At present it is unclear what sort of units are present in the prior art that applicants are attempting to distinguish over. In any case, the language suggested by the Examiner in the interview to overcome the prior art was "oxygen scavenging moieties consisting essentially of pendant cyclic olefinic groups", although it would not appear that the newly relied upon

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reference Gauthier would be overcome by such an amendment given that

Gauthier's units are pendant to the backbone.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,525,123. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims overlap with the claims of the patent given that ethylene vinyl alcohol is an oxygen barrier polymer and given that the structure shown has a pendant olefinic group and a cyclic moiety.

This Office action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

June 22, 2005

Jeffrey Mullis
Primary Examiner
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A handwritten signature in black ink, appearing to be 'J. Mullis', written below the printed name and title.